

## **REMARKS**

**[0003]** Applicant respectfully requests entry of the following remarks and reconsideration of the subject application. The Applicant respectfully requests entry of the amendments herein. The remarks and amendments should be entered under 37 CFR. § 1.116 as they place the application in better form for appeal, or for resolution on the merits.

**[0004]** Applicant respectfully requests reconsideration and allowance of all of the claims of the application. Claims 1, 5-9, 12-17, 19-24 and 33 are presently pending. Claims 1, 9, 17, 21 and 23 have been amended.

### **Statement of Substance of Interview**

**[0005]** The Examiner graciously talked with me—the undersigned representative for the Applicant—on 26 January 2009. The Applicant greatly appreciates the Examiner’s willingness to discuss the issues. Such willingness is invaluable to both of us in our common goal of an expedited prosecution of this patent application.

**[0006]** During the interview, I discussed aspects recited by claims yet not taught by the cited references, namely Hamann and Dancs. Without conceding the propriety of the rejections and in the interest of expediting prosecution, I also proposed several possible clarifying amendments.

**[0007]** The Examiner was receptive to the proposals, and I understood the Examiner to indicate that the proposed clarifying claim amendments appeared to distinguish over the cited art of record. For example, the Examiner indicated that

the amendments recited by the claims—including particularly that the root certificate was actually copied from the smartcard and into the computing device for operation, and was then removed from the computing device after removal of the smartcard—were particularly clarifying. However, the Examiner indicated that he would need to review the cited art more carefully and/or update the search.

**[0008]** Accordingly, the Applicant herein amends the claims in the manner discussed during the interview. Moreover, the Applicant submits that the pending claims are allowable over the cited references of record for at least the reasons discussed during the interview.

### **Formal Request for an Interview**

**[0009]** If the Examiner's reply to this communication is anything other than allowance of all pending claims, then I formally request an interview with the Examiner. I encourage the Examiner to call me—the undersigned representative for the Applicant—so that we can discuss this matter so as to resolve any outstanding issues quickly and efficiently over the phone.

**[0010]** Please contact me to schedule a date and time for a telephone interview that is most convenient for both of us. While email works great for me, I welcome your call as well. My contact information may be found on the last page of this response.

## **Claim Amendments**

**[0011]** Without conceding the propriety of the rejections herein and in the interest of expediting prosecution, Applicant amends claims 1, 9, 17, 21 and 23 herein. Applicant amends claims to clarify claimed features. Such amendments are made to expedite prosecution and more quickly identify allowable subject matter. Such amendments are merely intended to clarify the claimed features, and should not be construed as further limiting the claimed invention in response to the cited references.

**[0012]** Claim 1 is amended to recite subject matter from dependent claim 5. As indicated in paragraph [0007], the Examiner appeared to appreciated that copying the root certificate from the smartcard to the root certificate (see Fig. 3 and block 306), determining if the smartcard was removed from the computing device (see Fig. 4 and block 402) and removing the copied root certificate from the computing device (Fig. 4, blocks 404, 406) was not taught or suggested by the prior art of record.

**[0013]** Claims 9, 17, 21 and 23 were similarly amended.

## **Formal Matters**

**[0014]** The Examiner objects to claims 7 and 20 for a typo and depending from a non-existent claim, respectively. Herein, the Applicant has amended claim 7 and cancelled claim 20. Accordingly, the Applicant respectfully submits that these issues are resolved.

## **Substantive Matters**

### **Claim Rejections under § 103**

**[0015]** Claims 1, 5-9, 12-17, 19-24, 33 are rejected under 35 U.S.C. § 103. In light of the amendments presented herein and the decisions/agreements reached during the above-discussed Examiner interview, Applicant submits that these rejections are moot. Accordingly, Applicant asks the Examiner to withdraw these rejections.

**[0016]** The Patent Office previously based rejections on the following references in combination:

- Hamann et al, U.S. Patent Application No. 2002/0026578: Hamann et al, U.S. Patent Application No. 2002/0026578; and
- Dancs, U.S. Patent No. 6,108,789: Dancs, U.S. Patent No. 6,108,789.

**[0017]** Nevertheless, the Applicant will briefly review points made during the interview, outlining aspects recited by the claims, as amended, not taught or suggested by the Hamann or Dancs references.

**[0018]** The Applicant respectfully submits that the prior art fails to teach at least two elements recited by claims 1, 9, 17, 21 and 23 as amended. In particular, the prior art fails to teach or suggest moving the root certificate from the smart card to the computer. Additionally, the prior art fails to teach or suggest removing the root certificate from the computer when the smart card is removed from the computer.

**[0019]** Concerning moving the root certificate from the smartcard to the computer, the Applicant respectfully submits that Hamann and Dancs fail to teach or suggest any type of system or method configured for such functionality. Hamann teaches systems and methods by which “a secure import of certificates into a security token and their secure useage by applications” (see Hamann, Abstract, lines 3-5). Thus, Hamann teaches moving a certificate or key onto a smartcard—and not off of a smartcard. In fact, Hamann teaches that the smartcard prevents removal of a confidential key or certificate (see Hamann at [0005] last line and [0025] last line).

**[0020]** Claim 5 originally recited determining when the smart card is not operatively connected, and erasing the certificate on the computing device when the smart card is no longer operatively available. This aspect has been incorporated into the independent claims. In making out the rejection of claim 5, the Office pointed to [0028], [0036] and [0041]. However, the Applicant respectfully submits that these sections of the Hamann reference instead teach that a key can be deleted from the smartcard, and not from the device (e.g. a workstation) attached to the smartcard. Thus, the claims recite “erasing said root certificate from said computing device when said smartcard is no longer operatively available”, or similar. However, Hamann teaches that a key is erased from the smartcard (see particularly the result in Hamann at [0041]).

### **Dependent Claims**

**[0021]** Dependent claims 6-8, 12-16, 19, 22 and 24 ultimately depend upon their associated independent claims. The independent claims 1, 9, 17, 21 and 23

is allowable for at least the reasons discussed above. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

### **Conclusion**

[0022] All pending claims are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the application. If any issues remain that prevent issuance of this application, the **Examiner is urged to contact me before issuing a subsequent Action.** Please call or email me at your convenience.

Respectfully Submitted,

Lee & Hayes, PLLC  
Representatives for Applicant

/David S. Thompson/

Dated: 03/31/2009

David S. Thompson  
(DavidT@leehayes.com; 509-944-4735)  
Registration No. 37,954  
Customer No. **22801**

Telephone: (509) 324-9256  
Facsimile: (509) 323-8979  
[www.leehayes.com](http://www.leehayes.com)